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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/852,547

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David A. Sirbasku

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WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP  
111 MONUMENT CIRCLE, SUITE 3700  
INDIANAPOLIS, IN 46204-5137

EXAMINER

CANELLA, KAREN A

ART UNIT

PAPER NUMBER

1643

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/852,547	<b>Applicant(s)</b> SIRBASKU, DAVID A.	
	<b>Examiner</b> Karen A. Canella	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 95-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 95-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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### **DETAILED ACTION**

Claims 95 has been amended. Claims 96-109 have been added. Claims 95-109 are pending and under consideration.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 95 and 102-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 95 is vague and indefinite because it lacks active methods steps by which to carry out the “immunoglobulin steroid hormone inhibition assay” and the “immunoglobulin steroid inhibition positive control assay”. As the claim is now drafter a sample is simply treated to remove steroid hormones and added to steroid hormone receptor responsive tumor cells; the control sample is the addition of IgA or IgM to steroid hormone responsive cells. the claim requires that the “concentration” be determined at which said treated sample inhibits steroid hormone mediated cell growth. however, since the treated sample contains no steroid hormone and the cell lines are steroid hormone responsive, it would be expected that no growth would result due to lack of steroid hormones, irrespective of the presence or absence of an immunoglobulin steroid hormone response inhibitors in the sample. Further, it is unclear how a “concentration” is to be determined without knowing what the concentration is of.

Concentration is normally given in mass per unit volume, but the claim does not specify the molecule which is to be measured by concentration. The treated sample is any sample wherein steroid hormones have been effectively removed. When given the broadest reasonable interpretation, the treated sample can comprise a cell lysate. There are many molecules within the cell lysate which can be represented as mass per unit volume, and without a specific active method step dictating how the concentration is to be calculated, the metes and bounds of the claimed method cannot be determined.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 95-109 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 95 and 107 are drawn in part to a method requiring the steroid-hormone responsive cell line of GH4C1. Claim 108 requires the cell line of GH4C1. The originally filed disclosure fails to provide a description of GH4C1 cells. thus, one of skill in the art would reasonably conclude that applicant was not in possession of the claimed methods requiring said cells.

Claims 96 and 97 are drawn to methods wherein a samples of mucosal epithelial cultured cells is treated with polymeric IgM or polymeric IgA and another identical sample is left untreated. Bothe the treated and untreated cell samples are incubated under growth promoting conditions; and the cell population doublings of the cell samples are measured after the incubations, wherein a lack of increase in the cell population doublings of the cell sample treated with polymeric IgM or polymeric IgA with respect to the untreated samples is indicative of the presence of the mediator of immunoglobulin inhibition of steroid hormone responsive cell growth.

The originally filed disclosure fails to support the newly added claim. The specification states only that a method of detecting a mediator of immunoglobulin inhibition of steroid hormone responsive cell growth includes the detection of a poly-Ig receptor in a mucosal epithelial cell (para [0026]).

Claims 98-101 are drawn to methods of detecting estrogenic activity of a substance of interest comprising adding an inhibitory amount of IgM or IgA to at least two or thee samples of a maintained steroid hormone responsive cancer cell population; adding an amount of the

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substance of interest to one of the cell samples to yield a test mixture; designating the samples without any substance as a control; incubating the samples for a period of time; measuring the cell population in the samples after the period of time and comparing the test mixture cell population doublings with the control mixture cell population doubling, wherein a significant increase in cell population doublings in the test mixture indicates that the substance of interest possesses estrogenic activity.

the originally filed disclosure states that the estrogenic effect is calculated as the difference between cell population doublings in the presence and absence of steroid, which does not provide for the cell samples with and without IgA or IgM. One of skill in the art would reasonably conclude that applicant was not in possession of the claimed methods at the time of filing.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 98-101 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-43 of copending Application No. 09/852,958. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims, which require both a test sample and a control sample are obvious over the claims of the patent because it is within the purview of one of skill in the art to provide the appropriate control samples.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

All claims are rejected.

All other rejections as set forth in the previous Office action are withdrawn in light of applicants amendments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571)272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karen A Canella/

Primary Examiner, Art Unit 1643